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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/468,437	06/06/1995	TAKEO HODA	3408/589	5230

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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/468,437

Applicant(s)

HODA ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22 and 31-3437 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-22,33,34 and 40-49 is/are allowed.
- 6) ☒ Claim(s) 31,32,37 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 22 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. The specification fails to describe a first memory contain an IC card as now being recited in claims 21 , 22 and 43. It is noted that the specification teaches that the memory (claimed second semiconductor) that stored the image information from a buffer is an IC card (See Fig. 4).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claim 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Tojo et al (5,737,014).

Tojo discloses an editing device (Fig. 1, abstract, column 1) comprising

a first memory (27) for storing the processed image signal;
a processing means (19,9) (column 3, lines 39-42); and
a second memory (20) for storing the restored image signal from the first memory, the first memory and second memory are removable memories .

Applicant argues that the images stored in the memory card and in a medium of Toro apparatus are the same . In response, the examiner disagrees . It is noted that the images stored in the memory card that is a digital image format that is different format from the analog images format stored on the disc . The digital images read out from the memory card is restored to the analog format and then stored on the disc. Further it is noted that claim 51, does not specify whether the images stored in the memory is the same as or different from the images stored in the recorder.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 31, 37 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang in view of Sasaki et al (5.034,804) .

Regarding claims 31,37 and 51, Lang discloses an editing apparatus for comprising:

a first reception unit for receiving a memory (13)(column 6, lines 1-20).

a second reception unit (11) for receiving a memory device (column 3, lines 58 to column 4, line 16);

signal processing means (26) for expanding (restoring) the compressed image signal from the memory (column 9. lines 20-30); recording and reading means for recording and reading the expanded image signal (restored image signal) on and from the memory device (11.23) (column 3, lines 58-62, column 9, lines 1-68).

Lang further teaches that the memory is a semiconductor (SRAM)(column 6, lines 1-20), but fails to teach that the memory is a memory card, which is removable (column 6. lines 1-20).

However, it is noted that forming a SRAM memory as a memory card for recording image signal and using reception unit to enable the memory card can be removed from an apparatus is well known in the art as shown by Sasaki.

It would have been obvious to one of ordinary skill in the art to modify Lang with Sasaki by proving the memory SRAM memory of Lang as a memory card and a reception unit of the memory card as taught by Sasaki into the apparatus of Lang as an alternative to

memory 13 of Lang and incorporate a reception unit to enable the memory card can be received and removed from the apparatus in order to reduce the size of the overall apparatus and easily replace the memory card.

Further for claims 31 and 51, Lang as modified with Sasaki teaches that the image information is produced from a camera (See Lang and Sasaki references). In Remarks, applicants argue that Lang fails to teach that the memory is used as an image source . In response, the examiner disagrees, is noted that Lang teach that the memory 13 receiving the compressed image signal, the compressed image signal is read out from the memory 13 , expanded an then the expanded image signal is

recorded on a storage device or transmitted to another recording apparatus. It is clear that memory 13 of Lang is used as an image source . Applicants further argue that Lang does not teach or use the memory 13 as a removable memory card. In response. it is noted that the use of an IC card is well known in the art at the time the invention was made as admitted by applicants and is shown in prior art . Therefore, it would have been obvious to one of ordinary skill in the art to modify Lang by using a IC card as alternative of memory 13 in order to easily to preserve and/or replace the memory.

Applicants further argue that , Lang can not be combined with Sasaki because Lang teaches the storage of huge mage signal and Sasaki teach the stored of 8 seconds of the image signal . In response, it is noted that the amount of the image signal in the memory 13 is depended on the user operation. Therefore, the amount of the image signal stored in the memory 13 can be varied to the user operation. Further it is noted that nowhere in claims do they suggest or recite that limited amount of the

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image signal being stored in the IC card. Further it is noted that Lang teaches that the memory 13 can be SRAM or DRAM (column 6, lines 8-22) and that forming a SRAM as a memory card (IC card) that is removable is well known in the art and as taught by Sasaki . Therefore it would have been obvious to one of ordinary skill in the art to use the teaching of Sasaki to form the SRAM of Lang into a IC card that is removable from the apparatus .

Applicants further argue that the memory 13 disclosed by Lang is used for purpose of temporarily storing the images and the stored images are transferred to the recorder . In response, it is noted that applicants' argument reflects limitations in claim 31,51 and 57 over teaching of Lang since claim 31,51 and 57 recite that the compressed images is stored in the memory card and then the stored compressed images are transferred to the recorder.

7. Claim 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Lang in view of Sasaki et al as applied to claim 31 above, further in view of Watanabe et al . Lang fails to specifically teach that the image signal is compressed in a DCT manner. However, it is noted that expanding a compressed image signal in a DCT manner and stored the compressed image signal in a IC card is well known in the art as shown Watanabe . Therefore, it would have been obvious to one of ordinary skill in the art to modify Lang with Watanabe by providing apparatus of Lang with a DCT compressing and expanding means to compress and expand the image signals with a DCT manner in order to improve the quality of the image signal.

Allowable Subject Matter

8. Claims 20-22,33-34 and 40-49 are allowed over the cited art .

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 TECH CENTER customer service whose telephone number is (703) 306-0377.


HUY NGUYEN
PRIMARY EXAMINER

H.N
December 15, 2002